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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,999	08/29/2006	Raimund Ruppel	294908US0PCT	2460
22850	7590	05/05/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER KEYS, ROSALYND ANN				
ART UNIT		PAPER NUMBER		
1621				
NOTIFICATION DATE		DELIVERY MODE		
05/05/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/590,999

Applicant(s)

RUPPEL ET AL.

Examiner

ROSALYND KEYS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Claims 1-10 are pending.
Claims 1-10 are rejected.

Response to Amendment

Specification

2. The objection to the specification is withdrawn, due to the amendments to the specification, filed February 8, 2008.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 2 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 2 recites the limitation "wherein the antioxidant is used in a total amount that is at least 1.5 times the mass of DMC catalyst used" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim, since amended claim 1 requires a minimum of 2 times the amount of DMC catalyst used.
6. Claim 9 recites the limitation "comprising an antioxidant in an amount that is at least 1.5 times the mass of DMC catalyst " in lines 4 and 5. There is insufficient antecedent basis for this limitation in the claim, since amended claim 1 requires a minimum of 2 times the amount of DMC catalyst used.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herold (US 3,829,505) in view of Lawrey et al. (EP 0 759 450 A2).

Herold teaches a process for preparing polyether alcohols comprising reacting saturated alkylene oxide with at least one saturated OH compound in the presence of a double metal cyanide catalyst, wherein an antioxidant in an amount approximately equal to the amount of the catalyst is added prior to or after polymerization to avoid degradation which might occur

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(see entire disclosure, in particular column 1, line 42 to column 16, line 22). Suitable saturated alkylene oxides are disclosed in column 8, line 1 to column 9, line 14. Suitable saturated OH compounds are disclosed in column 2, line 63 to column 5, line 29. Suitable DMC catalysts are disclosed in column 9, line 15 to column 17, line 3 and the amounts are disclosed in column 16, lines 8-22. Suitable antioxidants are disclosed in column 6, lines 46-53. The polyethers are disclosed to be useful for making polyurethane foams (see column 7, lines 37-75). The polymer product has an OH functionality of at least 1 (see column 1, line 70 to column 2, line 12). The hydroxyl numbers are within the claimed amounts (see results at the bottom of columns 19 and 20).

Herold differs from the instant claims in that Herold does not disclose using an antioxidant in an amount of from 2 to 500 times the mass of catalyst. Herold does not specify using any particular antioxidant other than PBNA. Herold does not limit the amount of the DMC catalyst to the claimed amounts.

Lawrey et al. teach the use of double metal cyanide complexes in combination with antioxidants aid in stabilizing polyoxyalkylene polyether polyols (see entire disclosure, in particular the summary of invention on page 3). The amount of catalyst residue ranges from 10 to 250 ppm (see page 4, lines 5-9). The amount of antioxidant ranges from about 10 ppm to about 10,000 ppm (see page 4, lines 39-53). Examples of suitable antioxidants are disclosed on page 4, lines 39-49). The polymer product is disclosed to be useful for preparing polyurethane foams (see page 4, line 50 to page 5, line 7).

One having ordinary skill in the art at the time the invention was made would have found it obvious to utilize the antioxidants of Lawrey et al. and the amounts of antioxidant and DMC catalyst as disclosed by Lawrey et al. in the process of Herold as this would allow the skilled artisan the ability to obtain viscosity-stable isocyanate-terminated prepolymers (see page 4, line 39 to page 5, line 8 of Lawrey et al.).

Response to Arguments

11. Applicant's arguments filed February 8, 2008 have been fully considered but they are not persuasive, in part.

The Examiner considered *In re Chapman* and has removed the NOTE given at the bottom of page 4 of the previous office action, mailed November 8, 2007. Nonetheless the Examiner maintains the belief that the comparison is not being made with the closest prior art because the instant comparative examples do not include any antioxidant, whereas Herold teaches the use of an antioxidant in an amount approximately equal to the amount of the catalyst. Thus, since a comparison is not being made with an antioxidant in an amount approximately equal to the amount of the catalyst a comparison is not being made with the closest prior art and thus the prima facie case of obviousness has not been successfully rebutted.

For the above reasons, claims 1-10 remain unpatentable over Herold (US 3,829,505) in view of Lawrey et al. (EP 0 759 450 A2).

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

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calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROSALYND KEYS whose telephone number is (571)272-0639. The examiner can normally be reached on M, R & F 5:30-7:30 am & 1-5 pm; T & W 5:30 am-4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ROSALYND KEYS/
Primary Examiner, Art Unit 1621

April 25, 2008